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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,861	09/21/2000	Akiko Horiguchi	H&A-100-02	5941

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EXAMINER

ZIA, MOSSADEQ

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/666,861

Applicant(s)

HORIGUCHI ET AL.

Examiner

Mossadeq Zia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 21 September 0200.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: "when the right of obtaining a service by using the medium is granted to an owner of the medium, the identification data of the IC chip of the medium being stored in the memory as a data set about the owner."

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant states "when the right of obtaining a service by using the medium is granted to an owner of the medium, the identification data of the IC chip of the medium being stored in the memory as a data set about the owner". This examiner is unable to extract the intended meaning from the statement.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 8, 9, 10, 11, 12, 13 are rejected under 35 U.S.C. 102(b) as anticipated by Patent No. 5,721,781, Deo et al..

5. Regarding claim 8, Deo shows a method for the verification of data of a sheet shaped medium having an IC chip which is attached on or put in the medium (smart card, Deo, col. 4, line 36, 40) and which is constructed so that data stored in a memory of the IC chip can be sent in a radio communication (Deo, col. 4, line 46-47) between the IC chip and a communication device or means (external read/write equipment, Deo, col. 1, line 53-54), at least a portion of the data stored in the memory of the IC chip being identification data provided to the IC chip (certificate, Deo, col. 2, line 60-61);

when an owner of the medium has the right of obtaining a service (transaction session), the identification data of the IC chip of the medium is stored in the memory as a data set about the owner, and at least one item selected from the term for which the owner can obtain the service (Deo, col. 3, line 7-9), the number of times the owner can obtain the service and the remaining number of times the owner can obtain the service is stored using the identification data as a key in the memory as a data set wherein the data set is constructed so as to be updated successively (“unexpired certificate” implies time limit, col. 10, line 41);

the method comprising:

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receiving the identification data in the IC chip of the medium (exchange certificates, Deo, col. 3, line 7-9); and

verifying the received date against the date set to determine whether the owner has the right of obtaining the service (authenticate, Deo, col. 3, line 12).

6. Regarding claim 11, Deo shows a method for the verification of data of a sheet shaped medium having an IC chip which is attached on or put in the medium (smart card, Deo, col. 4, line 36, 40) and which is constructed so that data stored in a memory of the IC chip can be sent in a radio communication (Deo, col. 4, line 46-47) between the IC chip and a communication device or means (external read/write equipment, Deo, col. 1, line 53-54), at least a portion of the date stored in the memory of the IC chip being unique data which can be used for the distinguishment of the IC chip from other IC chips (certificate, Deo, col. 2, line 60-61);

for as long as the medium is circulated in marketplace (unexpired certificate, col. 10, line 41) and a flagging function for receiving a particular service is provided to the owner of the medium, the unique data of the IC chip of the medium or data obtained using the unique data as a key (public key) is stored in the memory as a data set about the owner to whom the flagging function is provided (secure communication, col. 3, line 13-15);

the method comprising:

receiving the unique data in the IC chip of the medium (exchange certificates, col. 3, line 7-9); and

verifying the received date against the date set to determine whether the owner has the right of obtaining the service (authenticate, Deo, col. 3, line 12).

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7. Regarding claims 9, 12 Deo shows claim 8 and 11 above, and further show wherein the sheet-shaped medium comprises one member selected from the group consisting of a paper, a plastic and a film with a peel-off sticker (one member: plastic, Deo, col. 4, line 49).

8. Regarding claim 10, 13, Deo shows claim 8 and 11 above, and further show that the sheet-shaped medium is intended to be used as a life insurance certificate, a non-life insurance certificate, a health insurance certificate, a merchandise coupon, a share certificate, a paper money, a ticket or a passenger ticket (col. 7, line 56-57).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, 3, 4, 5, 6, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No. 6,460,138, Morris in view of Patent No. 5,444,222, Inoue.

11. Regarding claim 1 Morris show a method for the determination of soundness of a sheetshaped medium having an IC chip which is attached on or put in the medium (smart card, Morris, col. 1, line 36-38) and which is constructed so that data stored in a memory of the IC chip can be sent between the IC chip and a communication device or means (protected electronic device, Morris, col. 1, line 53-54), at least a portion of the date stored in the memory (private key, col. 1, line 52) of the IC chip being at least one selected from first information about a facility of service which provides a first service which an owner of the medium can obtain by

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using the medium (digital keys, Morris, col. 1, line 41-42), second information which is personal information of the owner (PIN, Morris, col. 2, line 3-4) and third information which is unique to the IC chip and can be used for distinguishment of the IC chip from other IC chips (certificate, Morris, col. 2, line 28-29);

the information of a plurality of IC chips being manageable by storing at least one of the first, second and third information and a related information obtained using the information as a key in a memory (stored in memory, Morris, col. 1, line 53-54);

the method comprises:

receiving at least one of the first, second and third information in the IC chip
(prompt for PIN, col. 2, line 5-6);

reading the related information from the memory using at least one information as a key (private key is stored, Morris, col. 2, line 10-11); and

determining the soundness of the medium or a proof item or items of the medium based on the received information and the read information (authenticate, Morris, col. 2, line 1-2);

but, fail to show reader data stored in a memory of the IC chip can be sent in a radio mode by radio communication between the IC chip and communication device.

However, Inoue teaches a non-contact IC card, a terminal for use with the non-contact IC card, and a non-contact IC card system having the non-contact IC card and the terminal, wherein data communication can always be performed always normally within a communication distance range in which the IC card can be started up by a drive signal from the terminal (Inoue, col. 2, line 47-52).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Morris as per teaching of Inoue to gain the advantage of non-contact IC card capable of transmitting and receiving data through electromagnetic waves (Inoue, col. 1, line 9-10).

12. Regarding claim 2, Morris show a method for the verification of data of a sheet-shaped medium having an IC chip which is attached on or put in the medium (smart card, Morris, col. 1, line 36-38) and which is constructed so that data stored in a memory of the IC chip can be sent between the IC chip and a communication device or means (protected electronic device, Morris, col. 1, line 53-54), at least a portion of the data stored in the memory (private key, Morris, col. 1, line 52) of the IC chip being at least one selected from first information about a facility of service which provides a first service which an owner of the medium can obtain by using the medium (digital keys, Morris, col. 1, line 41-42), second information which is personal information of the owner (PIN, Morris, col. 2, line 3-4) and third information which is unique to the IC chip and can be used for distinguishment of the IC chip from other IC chips (certificate, Morris, col. 2, line 28-29);

when the owner of the IC chip has the right to obtain the first service (communicating parties, Morris, col. 1, line 39-41), at least one of the first, second and third information of the IC chip is stored in the memory as a data set about the owner (access to any number of services, Morris, col. 2, line 28-29);

the method comprising:

receiving at least one of the first, second and third information in the IC chip
(prompt for PIN, Morris, col. 2, line 5-6); and

verifying the received date against the date set (authenticate, Morris, col. line 6-8);

but, fail to show data stored in a memory of the IC chip can be sent in a radio mode by radio communication between the IC chip and a communication device.

However, Inoue teaches a non-contact IC card, a terminal for use with the non-contact IC card, and a non-contact IC card system having the non-contact IC card and the terminal, wherein data communication can always be performed always normally within a communication distance range in which the IC card can be started up by a drive signal from the terminal (Inoue, col. 2, line 47-52).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Morris as per teaching of Inoue to gain the advantage of non-contact IC card capable of transmitting and receiving data through electromagnetic waves (Inoue, col. 1, line 9-10).

13. Regarding claims 3, 6, Morris and Inoue shows claim 2 above, and further show wherein the sheet-shaped medium comprises one member selected from the group consisting of a paper, a plastic and a film with a peel-off sticker (one member: plastic, Morris, col. 1, line 36).

14. Regarding claim 4, 7, Morris and Inoue shows claim 2 above, and further show that the sheet-shaped medium is intended to be used as a life insurance certificate, a non-life insurance certificate, a health insurance certificate, a merchandise coupon, a share certificate, a paper money, a ticket or a passenger ticket (any number of services, col. 2, line 29).

15. Regarding claim 5, Morris shows method for the verification of data of a sheet-shaped medium having an IC chip which is attached on or put in the medium (smart card, Morris, col. 1,

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line 36-38) and which is constructed so that data stored in a memory of the IC chip can be sent between the IC chip and a communication device or means (protected electronic device, Morris, col. 1, line 53-54), at least a portion of the data stored in the memory of the IC chip being identification data provided to the IC chip (certificate, Morris, col. 2, line 28-29);

when the right of obtaining a service by using the medium is granted to an owner of the medium, the identification data of the IC chip of the medium being stored in the memory is a data set about the owner (Morris, col. 2, line 26-30);

the method comprising:

receiving the identification data in the IC chip (Morris, col. 2, line 219-22); and

verifying the received data against the data set to determine whether the owner has the right of obtaining the service (Morris, col. 2, line 29-30);

but, fail to show data stored in a memory of the IC chip can be sent in a radio mode by radio communication between the IC chip and a communication device.

However, Inoue teaches a non-contact IC card, a terminal for use with the non-contact IC card, and a non-contact IC card system having the non-contact IC card and the terminal, wherein data communication can always be performed always normally within a communication distance range in which the IC card can be started up by a drive signal from the terminal (Inoue, col. 2, line 47-52).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Morris as per teaching of Inoue to gain the advantage of non-contact IC card capable of transmitting and receiving data through electromagnetic waves (Inoue, col. 1, line 9-10).

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Conclusion

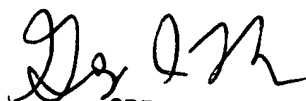
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mossadeq Zia whose telephone number is 703-305-8425. The examiner can normally be reached on Monday-Friday from 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mossadeq Zia
Examiner
Art Unit 2134

mz
4/19/04


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